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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/879,797	06/11/2001	Toshiaki Itoh	13452-011001 / PH-709US	3747

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EXAMINER

FORMAN, BETTY J

ART UNIT

PAPER NUMBER

1634

DATE MAILED: 06/05/2002

8

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/879,797

Applicant(s)

ITOH ET AL.

Examiner

BJ Forman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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### **DETAILED ACTION**

#### ***Priority***

1. Applicant's claim for domestic priority under 35 U.S.C. 120 is acknowledged. However, the Parent Application 09/451,666 filed 30 November 1999 upon which priority is claimed does not provide adequate support under 35 U.S.C. 112 for claim 6 of this application because the '666 application does not teach a v-shaped notch. Therefore, the effective filing date for instant claim 6 is the filing date of the instant application i.e. 11 June 2001.

#### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 2 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 is indefinite because it is unclear what structural limitations of the spotting pin are being described. The courts have stated that claims drawn to an apparatus must be distinguished from the prior art in terms of structure rather than function see *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA1959). "[A]pparatus claims cover what a device is, not what a device does." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (see MPEP, 2114). It is suggested that Claim 2 be amended to define the structural limitations of the claim.

Claim 5 is indefinite for the recitation "radially-shaped groove" because it is unclear how "radially" defines the shape of the "groove". According to the specification and drawings,

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the phrase "radially shaped groove" is used by the claim to mean "comprising multiple grooves which are perpendicular to the central axis of the pin." However, the accepted meaning of "radial" is a line relating to a radius and the accepted meaning of "shaped" is a process of forming. Given the accepted meanings of "radial" and "shaped", it is unclear how "radially" defines the shape of the groove.

While applicant may be his or her own lexicographer, a term in a claim may not be given a meaning repugnant to the usual meaning of that term. See *In re Hill*, 161 F.2d 367, 73 USPQ 482 (CCPA 1947).

#### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1- 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Brown et al (U.S. Patent No. 5,807,522, issued 15 September 1998).

Regarding Claim 1, Brown et al disclose a spotting pin wherein the tip of the pin comprises at least one recess i.e. channel (Column 7, lines 1-16 and Fig. 2, #14).

Regarding Claim 2, Brown et al disclose the spotting pin of Claim 1 and they disclose the spotting pin is used for spotting reagents (e.g. probe and/or binding agents) (Column 7, lines 55-65). The claimed spotting reagents do not define structural limitations of the spotting pin. Therefore, the claimed spotting reagents are not given any patentable weight. The courts have stated that a claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior

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art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987).

Regarding Claim 3, Brown et al disclose the recess is of concave shape i.e. the channel is concave relative to the tip of the pin (Column 7, lines 1-16 and Fig. 2, #14).

Regarding Claim 4, Brown et al disclose the spotting pin is formed by a pair of spaced-apart elongate members which converge at the tip or tip region or at least two elongate spaced-apart members adapted to hold a quantity of reagent solutions (Column 7, lines 6-12). The claim is drawn to a spotting pin wherein the tip comprises at least one groove. The pin of Brown et al has two spaced-apart elongate members illustrated in Fig. 2, as #12a and #12b. The space between the elongate members creates a groove (see Fig. 2 #14). The claims are given the broadest reasonable interpretation consistent with the broad claim language and specification wherein a groove is not defined. The courts have stated that claims must be given their broadest reasonable interpretation consistent with the specification *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997); *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969); and *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) (see MPEP 2111). Given the broadest reasonable interpretation, the pin of Brown et al is encompassed by the claimed pin.

Regarding Claim 5, Brown et al disclose the spotting pin is formed by a pair of spaced-apart elongate members which converge at the tip or tip region or at least two elongate spaced-apart members adapted to hold a quantity of reagent solutions (Column 7, lines 6-12). The claim is drawn to a spotting pin wherein the tip comprises a radially-shaped groove. As stated above, Claim 5 is rejected under 35 U.S.C. 112, second paragraph because it is unclear how “radially” defines the shape of the groove. For purposes of examination, the phrase is interpreted as multiple grooves positioned radially around the tip. The pin of Brown et al has at least two spaced-apart elongate members. Two spaced-apart elongate members are illustrated in Fig. 2, as 12a and 12b. The space between elongate members creates multiple

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(two) grooves at the tip, one directly across from the other. Brown et al teaches the pin comprises at least two spaced-apart elongate members. A pin of Brown et al comprising more than two elongate members would provide multiple grooves at the tip e.g. three elongate members would provide three grooves positioned radially around the tip. The claims are given the broadest reasonable interpretation consistent with the broad claim language and specification wherein "radially-shaped groove" is not defined. Given the broadest reasonable interpretation, the pin of Brown et al is encompassed by the claimed pin.

Regarding Claim 6, Brown et al disclose the spotting pin is formed by a pair of spaced-apart elongate members which converge at the tip or tip region or at least two elongate spaced-apart members adapted to hold a quantity of reagent solutions (Column 7, lines 6-12). The claim is drawn to a spotting pin wherein the tip comprises at least one V-shaped notch. The pin of Brown et al is formed by a pair of spaced-apart elongate members which converge at the tip or tip region. The tip region and converging elongate members are illustrated in Fig. 2. Also illustrated in Fig. 2 #14 is the V-shaped notch formed by the converging members. The claims are given the broadest reasonable interpretation consistent with the broad claim language and specification wherein "V-shaped notch" is not defined. Therefore, given the broadest reasonable interpretation, the pin of Brown et al is encompassed by the claimed pin.

Regarding Claim 7, Brown et al disclose a device comprising a spotting pin having a tip wherein the tip comprises at least one recess (i.e. dispensing device, Column 7, lines 16-35 and Fig. 1).

### **Conclusion**

6. No claim is allowed.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BJ Forman whose telephone number is (703) 306-5878. The examiner can normally be reached on 6:30 TO 4:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones can be reached on (703) 308-1152. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 308-8724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.



BJ Forman, Ph.D.  
Patent Examiner  
Art Unit: 1634  
May 23, 2002